

REMARKS

Claims 1-20 are pending in this application. Claims 1, 4, 5, 10, 13, and 17-19 have been amended by the present Amendment. Amended claims 1, 4, 5, 10, 13, and 17-19 do not introduce any new subject matter.

REJECTIONS UNDER 35 U.S.C. § 102

Reconsideration is respectfully requested of the rejection of claims 1-20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,219,130 ("Kawakubo").

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); M.P.E.P. § 2131.

Applicant respectfully submits that Kawakubo does not disclose or suggest stopping the method and making an error determination after failing to perceive or measure the overlay marks using a predetermined number of filters, as recited in amended claims 1, 13 and 19. These features are neither expressly nor inherently disclosed or suggested in Kawakubo. Indeed, in contrast to the claimed embodiments, Kawakubo discloses a system wherein transmittance is continuously changed and does not teach or suggest stopping the method and making an error determination. See Kawakubo, col. 5, lines 64-66.

Therefore, Applicant respectfully submits that independent claims 1, 13 and 19 are not anticipated by Kawakubo. Claims 2-12 depend from claim 1, claims 14-18

depend from claim 13 and claim 20 depends from claim 19, which, for the reasons stated hereinabove, are submitted not to be anticipated by the cited reference. For at least those very same reasons, claims 2-12, 14-18 and 20 are also submitted not to be anticipated by the cited reference.

Applicants also note that the sections in Kawakubo cited by the Examiner fail to disclose the first filter being the yellow filter, as recited in claim 7. Indeed, there is no discussion regarding yellow filters or order of filters.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-20 under 35 U.S.C. § 102(b) and that claims 1-20 are in condition for allowance.

Reconsideration is respectfully requested of the rejection of claims 1-3, 13 and 19-20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,151,121 ("Mishima").

Applicant respectfully submits that Mishima does not disclose or suggest stopping the method and making an error determination after failing to perceive or measure the overlay marks using a predetermined number of filters, as recited in amended claims 1, 13 and 19. These features are neither expressly nor inherently disclosed or suggested in Mishima.

Therefore, Applicant respectfully submits that independent claims 1, 13 and 19 are not anticipated by Mishima. Claims 2-3 depend from claim 1 and claim 20 depends from claim 19, which, for the reasons stated hereinabove, are submitted not to be anticipated by the cited reference. For at least those very same reasons, claims 2-3 and 20 are also submitted not to be anticipated by the cited reference.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-3, 13 and 19-20 under 35 U.S.C. § 102(b) and that claims 1-3, 13 and 19-20 are in condition for allowance.

An early and favorable reconsideration is earnestly solicited. If the Examiner has any further questions or comments, the Examiner may telephone Applicant's Attorney to reach a prompt disposition of this application.

Respectfully submitted,



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